

## **REMARKS**

### **I. Introduction**

Claims 1 to 23 are currently pending in the present application. In view of the following remarks, it is respectfully submitted that all of the presently pending claims are allowable, and reconsideration is respectfully requested.

Applicants note with appreciation the acknowledgment of the claim for foreign priority and the indication that all certified copies of the priority documents have been received.

Applicants thank the Examiner for considering the previously filed Information Disclosure Statement, PTO-1449 paper, and cited references.

### **II. Requested Information**

As regards the request for a copy of ISO 10303, Applicants submit herewith a copy of "Product Data Exchange Using STEP -- Part 1 -- Overview and Fundamental Principles," US PRO ISO 10303-1:1994.

### **III. Rejection of Claim 9 Under 35 U.S.C. § 112**

Claim 9 was rejected under 35 U.S.C. § 112, second paragraph as indefinite for allegedly failing to particularly point out and distinctly claim the subject matter of the invention. Applicants respectfully submit that the rejection should be withdrawn for the following reasons.

The Office Action contends at page 2 that "the term 'an adaptor' [sic] is not adequately defined" and that "it is not clear how said 'adapter' is distinct from the term 'data circuit' of claim 1 and claim 9." Claim 1 recites, inter alia, "at least one central data base connected to the at least one CAX system via a data circuit configured to exchange data," and claim 9 recites, inter alia, "an adapter connecting the data circuit and the at least one CAX system." The present rejection is not understood, since claims 1 and 9 make sufficiently clear the arrangement of the data circuit and the arrangement of the adapter.

The Office Action appears to ignore the case law, which plainly provides that the terms of a claim must be given "reasonable interpretations" based on the Specification -- and not simply any broad and unrestricted reading of those terms. See In re Weiss, 26 U.S.P.Q.2d 1885, 1887 (Fed. Cir. 1993) (when interpreting a claim term or phrase, one must "look to the specification for the

meaning ascribed to that term"; Board reversed) (unpublished decision); In re Okuzawa, 190 U.S.P.Q. 464, 466 (C.C.P.A. 1976) ("claims are not to be read in a vacuum, and limitations therein are to be interpreted in light of the specification in giving them their broadest reasonable interpretation"; Board reversed; emphasis in original) (citing In re Royka, 180 U.S.P.Q. 580, 582 to 83 (C.C.P.A. 1974) (claims are "not to be read in a vacuum and while it is true that they are to be given the broadest reasonable interpretation during prosecution, their terms still have to be given the meaning called for by the specification of which they form a part"; Board reversed; emphasis in original); and In re Rohrbacher, 128 U.S.P.Q. 117, 119 (C.C.P.A. 1960) (an "applicant is his own lexicographer and words used in his claims are to be interpreted in the sense in which they are used in the specification"; Board reversed)). It is respectfully submitted that this is exactly the case here since contrary to the foregoing law, the Office Action apparently simply reflects its own unreasonable reading of the terms "adapter," "data circuit," "central data bus [sic]" and "application programming interface" without regard to the sense in which that phrase is used in the present application.

Furthermore, as provided in M.P.E.P. § 2173.02, the "focus during examination of claims for compliance with the requirement for definiteness of 35 U.S.C. 112, second paragraph is whether the claim meets the threshold requirement of clarity and precision." In this regard, the "essential inquiry pertaining to this requirement is whether the claims set out and circumscribe a particular subject matter with a reasonable degree of clarity and particularity." Id. (emphasis added). "Definiteness of claim language must be analyzed, not in a vacuum, but in light of[, inter alia, the] content of the particular application disclosure[ and the] claim interpretation that would be given by one possessing the ordinary level of skill in the pertinent art at the time the invention was made." Id. If the claims, when read in light of the Specification, reasonably apprise those skilled in the art both of the utilization and scope of the subject matter claimed, and if the language is as precise as the subject matter permits, the second paragraph of 35 U.S.C. § 112 demands no more. M.P.E.P. § 2173.05(a) (citing Shatterproof Glass Corp. v. Libbey Owens Ford Co., 758 F.2d 613, 225 U.S.P.Q. 634 (Fed. Cir. 1985)).

In view of all of the foregoing, it is respectfully submitted that claim 9 fully complies with the definiteness requirement of 35 U.S.C. § 112, and withdrawal of this rejection is respectfully requested.

#### IV. Rejection of Claims 1 to 23 Under 35 U.S.C. § 103(a)

Claims 1 to 23 were rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of Applicants' alleged admissions (the "background") and James D. Foley et al., Computer Graphics (Addison-Wesley Publishing Company 2d ed. 1990) ("Foley et al."). Without addressing the Office Action's claim interpretations -- and with acquiescing thereto -- Applicants respectfully submit that the combination of the background and Foley et al. does not render unpatentable claims 1 to 23 for the following reasons.

As an initial matter, in addressing the merits of this rejection, Applicants do not concede the correctness of the Office Action's characterization of the subject matter appearing on page 1 of the Specification as prior art, but will proceed, for the sake of argument only, on the premise that the Office Action's characterization is accurate. Therefore, when framed accordingly, the argument of Applicants is that even if the Office Action is correct in characterizing page 1 of the Specification as prior art, the subject matter of claims 1 to 23 is still be patentable over such alleged "admissions."

To establish a prima facie case of obviousness, an Office Action must demonstrate three criteria: (1) there must be some suggestion or motivation to one of ordinary skill in the art to modify a reference or to combine reference teachings; (2) there must be a reasonable expectation of success; and (3) the prior art reference (or references when combined) must teach or suggest each and every limitation in the claim under examination. In re Vaeck, 947 F.2d 488 (Fed. Cir. 1991).

Claim 1 relates to a design system. Claim 1 recites that a selection device is configured to select preexisting parts that overlap and/or border the design space of a part to be designed, and recites a copying device configured to copy to the CAx system as a design-space environment the selected parts with data representing a position of the selected parts relative to the design space of the part to be designed. Claim 1 further recites that the CAx system includes an input device to design the part to be designed. Thus, the design-space environment, which includes data representing a position of preexisting parts relative to the design space of the part to be designed, is copied to the system that is configured for designing the part to be designed.

The Office Action asserts that the background discloses the claimed copying device, except that instead of performing intersection calculations in the

CAX system, the background discloses performing intersection calculations in the vehicle database. However, claim 1 does not recite the mere change of location for collision testing. Collision testing is performed to ascertain the feasibility of parts **that have been designed**. Claim 1 recites the copying into a system a design-space environment with data representing the position of preexisting parts relative to a design space of a **part to be designed**. Nowhere does the background disclose or suggest copying into a system a design-space environment with data representing a position of preexisting parts relative to a design space of a part to be designed.

The background discusses a vehicle database in which is saved the part to be designed. The vehicle database performs collision testing. If discrepancies occur, the part to be designed must be modified. The background states that the procedure may have to be repeated several times. The necessity for repeating the procedure numerous times arises because the system configured for designing the part to be designed is not presented with a design-space environment. The vehicle database performs calculations to determine whether two parts **that have been designed** intersect. The vehicle database returns the results to the system configured for designing a part to be designed. Since a design-space environment is not returned and only the results of the calculation indicating that the designed part that has been designed is not feasible are returned, when a new piece is designed, it is not designed according to an existing environment. This leads to new design errors. Thus, the background describes a system substantially different than that of claim 1. Thus, the combination of the background and Foley et al. does not disclose or suggest all of the limitations of claim 1.

It is therefore respectfully submitted that the combination of the background and Foley et al. does not render unpatentable claim 1.

Claim 11 relates to a method for designing new parts of a design unit. Claim 11 recites copying to the CAX system data representing a position of preexisting parts relative to the design space of the part **to be designed**. As set forth above with respect to the patentability of claim 1, the background does not teach or suggest copying to a system data representing a position of preexisting parts relative to a design space of a part that is to be designed. Thus, the combination of the background and Foley et al. does not disclose or suggest all of the limitations of claim 11.

It is therefore respectfully submitted that the combination of the background and Foley et al. does not render unpatentable claim 11.

With respect to claims 2 to 10, which ultimately depend from and therefore include all of the limitations of claim 1, it is respectfully submitted that the combination of the background and Foley et al. does not render these dependent claims unpatentable for the same reasons set forth above with respect to the patentability of claim 1. In re Fine, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988) (any dependent claim that depends from a non-obvious independent claim is non-obvious).

With respect to claims 12 to 23, which ultimately depend from and therefore include all of the limitations of claim 11, it is respectfully submitted that the combination of the background and Foley et al. does not render these dependent claims unpatentable for the same reasons set forth above with respect to the patentability of claim 11. Id.

**V. Conclusion**

In light of the foregoing, it is respectfully submitted that all of the presently pending claims are in condition for allowance. Prompt reconsideration and allowance of the present application are therefore earnestly solicited.

Respectfully submitted,

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